

Attorney Docket No.: ISPH-0623
Inventors: Karras and Condon
Serial No.: 10/033,742
Filing Date: December 28, 2001
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The claims of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 and 37 C.F.R. §1.141 by the Examiner in this case as follows:

Group I, claims 1-14 drawn to a compound 8-50 nucleobases in length targeted to a nucleic acid molecule encoding macrophage inflammatory protein 3-alpha (MIP-3 α) and compositions thereof classified in class 536 subclass 24.5.

Group II, claims 15-20, drawn to a method of inhibiting the expression of MIP-3 α and for treating an animal having a disease or condition associated with MIP-3 α , classified in class 514, subclass 44.

The Examiner suggests that the Groups are distinct in that they are related as product and process of use. The Examiner further suggests that claim 3 specifically claims multiple individual antisense sequences each of which are deemed to be unrelated. The Examiner suggests that the sequences are distinct as each SEQ ID NO. is a unique nucleotide sequence, and each sequence targets different and specific regions of the nucleic acid encoding MIP-3 α , modifying expression of the gene to varying degrees. The Examiner suggests that a search of more than one of the identified antisense sequences presents an undue burden on the Patent and Trademark Office. The Examiner has required Applicants

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to elect one sequence. Applicants respectfully traverse this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of claims of the instant application relate to the single concept of MIP-3 α modulation. Accordingly, each of the claims contain the components for use in the same endpoint, namely modulation of MIP-3 α expression. Thus, Applicants respectfully disagree that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01. Further, a single search relating to MIP-3 α modulation would identify art related to all of the claims of this application and would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria

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as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

Further, as acknowledged by the Examiner, all of the identified SEQ ID NOS of claim 3 share the ability to modulate a common structure, namely the MIP-3 α gene. Thus, Applicants respectfully disagree that the sequences are distinct as being novel and unobvious over each other, as required by MPEP § 802.01. Accordingly, reconsideration and withdrawal of the single species election requirement of the sequences recited in claim 3 is respectfully requested.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group I, claims 1-14, and SEQ ID NO: 3, with traverse. Claim 3 has been canceled. Claim 1 and claim 11 have been amended to clarify that the claimed invention is a compound targeted to a single disclosed species of the MIP-3 α namely, SEQ ID NO: 3. Support for this amendment is found throughout the specification and at Table 1, pages 104-105. Applicants believe that these amendments satisfy the requirements of this Restriction Requirement.

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Attached hereto is a marked up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings to Show Changes Made."

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 3 has been canceled.

Claims 1 and 11 have been amended as follows:

1. (Amended) A compound 8 to 50 nucleobases in length targeted to a nucleic acid molecule encoding macrophage inflammatory protein 3-alpha (SEQ ID NO: 3), wherein said compound specifically hybridizes with said nucleic acid molecule encoding macrophage inflammatory protein 3-alpha and inhibits the expression of macrophage inflammatory protein 3-alpha.

11. (Amended) A compound 8 to 50 nucleobases in length which specifically hybridizes with at least an 8-nucleobase portion of an active site on a nucleic acid molecule encoding macrophage inflammatory protein 3-alpha (SEQ ID NO: 3).